

**REMARKS*****Summary of the Amendment***

Upon entry and consideration of the instant amendment, claims 13, 30 and 37 will have been amended and claims 38-40 will have been added. Accordingly, claims 13-40 will be pending and under consideration.

***Summary of the Official Action***

In the instant Office Action, the Examiner rejected claims 13-37 as being indefinite. The Examiner also rejected claims 13-37 over the applied art of record. By the present remarks, Applicant submits that the objections and rejections have been overcome, and respectfully request reconsideration of the outstanding Office Action and allowance of the present application.

***Interview of February 15, 2011***

Applicant appreciates the courtesy extended by Examiner Bellinger in the Interview of February 15, 2011. In the Interview, Applicant's representative discussed the following:

In regards to the Section 112, 2<sup>nd</sup> paragraph, rejection, Applicant would point in a response how one of ordinary skill in the art, reading the claims in light of the specification and drawings, would have no difficulty understanding the claimed invention. The Examiner agreed to reconsider this rejection after reviewing Applicant's response with such arguments and citing case law and the new USPTO guidelines for interpreting claims under Section 112, 2<sup>nd</sup> paragraph, rejection.

In regards to the prior art rejections, it was pointed out that JP '354 has not been shown to teach or suggest the annular limbs are flexible and that they have deformable sealing elements. It is

not apparent whether JP '354 specifically teaches such features as no English language translation of the same has been provided. In response, the Examiner indicated that he would consider Applicant's comments and arguments regarding the same in a response and acknowledged that he would need to obtain an English language translation of this document to support the noted rejection and address Applicant's arguments.

Finally, Applicant's representative pointed out that JP '354 teaches various embodiments which utilize one or more reinforcements in the annular limbs (see member 6 in Fig. 4), and that the invention does not utilize such reinforcements in the limbs. Applicant's representative specifically indicated that Applicant was not adverse to specifically reciting this feature in each of the independent claims in an effort to advance prosecution.

In response, the Examiner indicated that adding such a negative limitation may constitute new matter if this feature was not specifically disclosed in the instant specification. Applicant's representative responded that Applicant has shown a cross-section in, e.g., Fig. 2, which by itself provides full and sufficient support for not utilizing any reinforcements in the annular limbs, and that Applicant would provide the Examiner with one or more Board decisions which supports Applicant's contention that drawings alone can satisfy the written description requirement.

Applicant appreciates the Examiner's agreement to review and consider such arguments as well as any Board decisions provided to the Examiner.

***The Instant Amendment Does Not Add New Matter***

In response to the Examiner's concern (asserted in the Interview of February 15, 2011) that the proposed amendment to the independent claims may possibly constitute new matter, Applicant

reminds the Examiner Fig. 2 clearly provides full and clear support for the added language and notes the following.

To the extent that the Examiner believes that each claim feature is required to have full and express support in the description as implied in the Interview, Applicant reminds the Examiner that “the failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented.” See *All Dental Prodx, LLC v. Advantage Dental Products, Inc.*, 309 F.3d 774 (Fed. Cir. 2002) noting *Eiselstein v. Frank*, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995). A copy of the *All Dental Prodx* was previously made of record.

Applicant also directs the Examiner’s attention to the non-precedential decision in *Ex parte COFFEY* which specifically explains, on pages 4 and 5, that the drawings (in this case Fig. 2 of the instant application) can be relied upon to provide written description support for negative claim features shown therein. See also pages 4 and 5 of non-precedential decision in *Ex parte BOGRETT et al.* Copies of each of these Board decisions are attached hereto.

It is also emphasized that the drawings by themselves have been held to be sufficient to satisfy the written description requirement. See also page 6 of non-precedential decision in *Ex parte PARRA et al.*, a copy of this Board decision is attached hereto.

Thus, it is submitted that one having ordinary skill in the art would readily recognize from at least Fig. 2 all of the features of the claimed invention in view of the disclosure of the instant application.

***The Section 112, 2<sup>nd</sup> Paragraph, Rejection, is Improper***

The Examiner rejects claims 13-37 as being indefinite with regard to certain features alleged to render these claims unclear.

As noted in the Interview, when the claims are interpreted by one having ordinary skill in the art in light of the specification and drawings, each feature alleged to be unclear is in fact clear and understandable.

As emphasized in the Interview, the new guidelines regarding definiteness as well as the MPEP specifically require definiteness to be measured from the standpoint of one having ordinary skill in the art and in light of the specification. MPEP §2173.02 particularly explains that the test for definiteness under 35 U.S.C. 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the disclosure." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) the content of the particular application disclosure; (B) the teachings of the prior art; and (C) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. Moreover, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. *Energizer Holdings Inc. v. Int'l Trade Comm'n*, 435 F.3d 1366, 77 USPQ2d 1625 (Fed. Cir. 2006). MPEP §2173.05(e).

As pointed out in the Interview, as each claim feature is shown and described in Applicant's disclosure (and as the Examiner has not demonstrated otherwise) and as the Examiner has not interpreted the claims as one ordinarily skilled in the art in light of the description, it is submitted

that a *prima facie* case of indefiniteness has not been properly set forth.

It is submitted that each claim feature can be read at least on the embodiment shown in Fig. 2 of the drawings and its description in the specification. In particular, Fig. 2 shows limbs 31 and 32 pointing away from central body 30, as well as sealing elements 33-36 projecting radially inwardly from a surface of each limb, and by the same amount.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

### ***Traversal of Rejection Under 35 U.S.C. § 102***

Applicant traverses the rejection of claims 13-14, 16, 17, 22, 23, 25, 26, 29-31 and 35-37 under 35 U.S.C. §102(b) as being anticipated by JP 32-5354.

In the rejection, the Examiner asserted that Fig. 4 of JP '354 discloses all the recited features of these claims, including the recited deformable sealing elements. Applicant respectfully traverses this rejection.

Applicant respectfully submits that this rejection is improper because JP '354 has not been shown to teach, or even suggest: inter alia, that, when the sealing ring is in an un-installed state, the deformable sealing elements are arranged on and project from a radially inwardly pointing surface of each annular limb so as to extend over a circumference of the annular limb, as recited in independent claim 13; inter alia, a sealing ring that, in an un-installed state, comprises first deformable sealing elements formed on the first flexible member and projecting from the inner surface toward the rim outer surface when the sealing ring is installed on the vehicle wheel and second deformable sealing elements formed on the second flexible member and projecting from the inner surface toward the rim outer surface when the sealing ring is installed on the vehicle wheel, wherein free ends of the first

deformable sealing elements define different diameters on the first side and free ends of the second deformable sealing elements define different diameters on the second side, as recited in independent claim 30; and inter alia, that a circumferential thickness of the first flexible member is greater in a portion of the first flexible member having the first deformable sealing elements than at a portion of the first flexible member arranged adjacent the central annular body and that a circumferential thickness of the second flexible member is greater in a portion of the second flexible member having the second deformable sealing elements than at a portion of the second flexible member arranged adjacent the central annular body, as recited in independent claim 37.

As was pointed out in the Interview and as was apparently acknowledged by the Examiner in the Interview, JP '354 has not been shown to teach or suggest annular limbs that are flexible and that have deformable sealing elements. Accordingly, Applicant requests that this rejection be withdrawn unless and until the Examiner demonstrates (by providing an English language translation) that such features are taught in JP '354.

Furthermore, it is submitted that because each of the embodiments shown in the drawings of JP '354 show a reinforcement in the limbs, this rejection is also improper because claims 13, 30 and 37 now recite that each annular limb contains therein no reinforcement.

For the foregoing reasons and because this document fails to disclose the above-noted features of the instant invention, Applicant submits that this document fails to disclose each and every recited feature of claims 13, 30 and 37. Accordingly, Applicant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 102(b) and that the instant rejection is improper.

Finally, Applicant submits that dependent claims 14, 16, 17, 22, 23, 25, 26, 29, 31, 35 and 36

are allowable at least for the reason that these claims depend from an allowable base claim and because these claims recite additional features that further define the present invention.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection and further requests that the above noted claims be indicated as allowable.

***Traversal of Rejections Under 35 U.S.C. § 103***

**Over JP '354 alone**

Applicant traverses the rejection of claims 15 and 32-34 under 35 U.S.C. §103(a) as being unpatentable over JP '354 alone.

In the rejection, the Examiner asserted that JP '354 disclosed or suggested all the recited features of these dependent claims. Applicant respectfully traverses this rejection.

As explained above, Fig. 4 of JP '354 has not been shown to teach or suggest annular limbs that are flexible and that have deformable sealing elements. Accordingly, Applicant submits that this rejection should be withdrawn unless and until the Examiner demonstrates (by providing an English language translation) that such features are taught in JP '354. Furthermore, it is submitted that because each of the embodiments shown in the drawings of JP '354 show a reinforcement in the limbs, this rejection is also improper because claims 13 and 30 now recite that each annular limb contains therein no reinforcement.

For the foregoing reasons and because JP '354 alone fails to disclose the above-noted features of the instant invention, Applicant submits that no proper modification of this document discloses or suggests each and every recited feature of claims 13 and 30. Accordingly, Applicant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of unpatenability

under 35 U.S.C. § 103(a) and that the instant rejection is improper.

Finally, Applicant submits that dependent claims 15 and 32-34 are allowable at least for the reason that these claims depend from an allowable base claim and because these claims recite additional features that further define the present invention.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection and further requests that the above noted claims be indicated as allowable.

Over JP '354 with Veux

Applicant traverses the rejection of claims 18, 19, 21, 24, 27 and 28 under 35 U.S.C. §103(a) as being unpatentable over JP '354 in view of U.S. Patent No. 7,104,300 to VEUX et al.

In the rejection, the Examiner asserted that a fair combination of the teachings of JP '354 and VEUX discloses all the recited features of these claims. Applicant respectfully traverses this rejection.

As explained above, Fig. 4 of JP '354 has not been shown to teach or suggest annular limbs that are flexible and that have deformable sealing elements. Accordingly, Applicant submits that this rejection should be withdrawn unless and until the Examiner demonstrates (by providing an English language translation) that such features are taught in JP '354. Furthermore, it is submitted that because each of the embodiments shown in the drawings of JP '354 show a reinforcement in the limbs, the rejection over JP '354 alone is also improper because claims 13 and 30 now recite that each annular limb contains therein no reinforcement.

VEUX does not cure the deficiencies of JP '354. Applicant notes that the ring shown in Fig. 2 of VEUX, for example, shows no deformable elements arranged on rim facing surface of members



26 and 28-31. As such, VEUX, like JP '354, fails to teach or suggest the recited deformable sealing elements, much less, that, when the sealing ring is in an un-installed state, the deformable sealing elements are arranged on and project from a radially inwardly pointing surface of each annular limb so as to extend over a circumference of the annular limb, as recited in claim 13.

For the foregoing reasons and because each of these documents fails to disclose the above-noted features of the instant invention, Applicant submits that no proper combination of these documents disclose or suggests each and every recited feature of claim 13. Accordingly, Applicant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of unpatentability under 35 U.S.C. § 103(a) and that the instant rejection is improper.

Finally, Applicant submits that dependent claims 18, 19, 21, 24, 27 and 28 are allowable at least for the reason that these claims depend from an allowable base claim and because these claims recite additional features that further define the present invention.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection and further requests that the above noted claims be indicated as allowable.

Over JP '354 with Veux with Medynski

Applicant traverses the rejection of claim 20 under 35 U.S.C. §103(a) as being unpatentable over JP '354 and VEUX and further in view of U.S. Patent No. 1,621,021 to MEDYNSKI.

In the rejection, the Examiner asserted that a fair combination of the teachings of JP '354 and MEDYNSKI discloses all the recited features of these claims. Applicant respectfully traverses this rejection.

Applicant reiterates the arguments made above regarding JP '354 and VEUX in reference to

claim 13.

MEDYNSKI does not cure the deficiencies of any proper combination of JP '354 and VEUX. It is noted that the ring shown in Fig. 3 of MEDYNSKI, for example, shows no deformable elements arranged on rim facing surface of members 10. As such, MEDYNSKI, like JP '354 and VEUX, fails to teach or suggest the recited deformable sealing elements, much less, that, when the sealing ring is in an un-installed state, the deformable sealing elements are arranged on and project from a radially inwardly pointing surface of each annular limb so as to extend over a circumference of the annular limb, as recited in claim 13.

For the foregoing reasons and because each of these documents fails to disclose the above-noted features of the instant invention, Applicant submits that no proper combination of these documents disclose or suggests each and every recited feature of claim 13. Accordingly, Applicant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of unpatenability under 35 U.S.C. § 103(a) and that the instant rejection is improper.

Finally, Applicant submits that dependent claim 20 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection and further requests that the above noted claims be indicated as allowable.

Over GB '784 with DE '738

Applicant traverses the rejection of claims 13-17, 22, 23 and 26 under 35 U.S.C. §103(a) as being unpatentable over GB 787,784 in view of DE 1 021 738.

In the rejection, the Examiner asserted that a fair combination of the teachings of GB '784 and DE '738 disclosed or suggested all the recited features of these claims, including the recited deformable sealing elements. Applicant respectfully traverses this rejection.

Applicant respectfully submits that this rejection is improper because no proper combination of GB '784 and DE '738 discloses or suggests: inter alia, that, when the sealing ring is in an un-installed state, the deformable sealing elements are arranged on and project from a radially inwardly pointing surface of each annular limb so as to extend over a circumference of the annular limb, as recited in independent claim 13.

Applicant acknowledges that the figure of GB '784 shows a tire 4 and a sealing ring 5 having annular limbs 7 with grooves 8. Applicant submits, however, that GB '784 only shows what the ring 5 looks like in an installed state and with the tire under pressure. Thus, it is not apparent that GB '784 teaches or suggests the recited deformable sealing elements, much less, that, when the sealing ring is in an un-installed state, the deformable sealing elements are arranged on and project from a radially inwardly pointing surface of each annular limb so as to extend over a circumference of the annular limb, as recited in claim 13.

DE '738 does not cure the deficiencies of GB '784. While Applicant acknowledges that DE '738 teaches a sealing member 4 which apparently utilizes deformable members, it is apparent that one having ordinary skill in the art would substitute of the grooves 8 of the member shown in GB '784 with the deformable members of member 4 of DE '738. Applicant notes that the member 4 in DE '738 apply an essentially axial force to axial annular surfaces of the beads 2 of the tire whereas the grooves 8 of member 5 in GB '784 apply an essentially radially inwardly directed force to an essentially circumferential outer surface (albeit tapered) above the bead 3.

This distinction is not without a difference. While the grooves 8 of GB 784 press against a portion of the tire along a generally radial direction whose force vector intersects an outer circumferential portion of the rim 1, the so-called deformable member of the member 4 in DE '738 press against a portion of the tire along an axial direction whose force vector does not intersect an outer circumferential portion of the rim.

Furthermore, it is submitted that the asserted combination/modification appears improper because the so-called deformable members of member 4 of DE '784 are oriented axially to bias the tire beads axially outwardly to seat the beads in the rim whereas the grooves on member 5 of GB '784 point down towards the inner surface of the tire above the beads and appear to play no role in biasing the tire beads axially outwardly to seat the beads in the rim. Instead, in GB '784, it appears to be the center portion 5a (not the wings 7) which biases the tire beads axially outwardly to seat the beads in the rim.

Finally, it is emphasized that none of the applied documents even remotely disclose or suggest that the deformable sealing elements are arranged on and project from a radially inwardly pointing surface of each annular limb (claim 13). Again, the sealing member 5 shown in GB '784 shows grooves 8 arranged in the wings 7, but nothing projecting from a radially inwardly pointing surface of each annular limb. Similarly, the sealing member 4 shown in DE '738 shows projections arranged in axial end surfaces, but not on any wings and these projections clearly do not project from a radially inwardly pointing surface of each annular limb.

For the foregoing reasons and because each of these documents fails to disclose the above-noted features of the instant invention, Applicant submits that no proper modification of this document disclose or suggests each and every recited feature of claim 13. Accordingly, Applicant

submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of unpatenability under 35 U.S.C. § 103(a) and that the instant rejection is improper.

Finally, Applicant submits that dependent claims 14-17, 22, 23 and 26 are allowable at least for the reason that these claims depend from an allowable base claim and because these claims recite additional features that further define the present invention.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection and further requests that the above noted claims be indicated as allowable.

Over GB '784 and DE '738 with Veux

Applicant traverses the rejection of claims 18, 19, 21, 24, 27 and 28 under 35 U.S.C. §103(a) as being unpatentable over GB '784 and DE '738 in view of VEUX.

In the rejection, the Examiner asserted that a fair combination of the teachings of GB '784, DE '738, and VEUX discloses all the recited features of these claims. Applicant respectfully traverses this rejection.

Applicant reiterates the arguments made above regarding GB '784 and DE '738 in reference to claim 13.

VEUX does not cure the deficiencies of GB '784 and DE '738. The ring shown in Fig. 2 of VEUX, for example, shows no deformable elements arranged on rim facing surface of members 26 and 28-31. As such, VEUX, like GB '784, fails to teach or suggest the recited deformable sealing elements, much less, that, when the sealing ring is in an un-installed state, the deformable sealing elements are arranged on and project from a radially inwardly pointing surface of each annular limb so as to extend over a circumference of the annular limb, as recited in claim 13.

For the foregoing reasons and because each of these documents fails to disclose the above-noted features of the instant invention, Applicant submits that no proper combination of these documents disclose or suggests each and every recited feature of claim 13. Accordingly, Applicant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of unpatenability under 35 U.S.C. § 103(a) and that the instant rejection is improper.

Finally, Applicant submits that dependent claims 18, 19, 21, 24, 27 and 28 are allowable at least for the reason that these claims depend from an allowable base claim and because these claims recite additional features that further define the present invention.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection and further requests that the above noted claims be indicated as allowable.

Over GB '784, DE '738, and Veux with Medynski

Applicant traverses the rejection of claim 20 under 35 U.S.C. §103(a) as being unpatentable over GB '784, DE '738, and VEUX and further in view of MEDYNSKI.

In the rejection, the Examiner asserted that a fair combination of the teachings of GB '784, DE '738, VEUX and MEDYNSKI discloses all the recited features of these claims. Applicant respectfully traverses this rejection.

Applicant reiterates the arguments made above regarding GB '784, DE '738 and VEUX, and claim 13.

MEDYNSKI does not cure the deficiencies of GB '784, DE '738 and VEUX. The ring shown in Fig.3 of MEDYNSKI, for example, shows no deformable elements arranged on rim facing surface of members 10. As such, MEDYNSKI, like GB '784 and VEUX, fails to teach or suggest

the recited deformable sealing elements, much less, that, when the sealing ring is in an un-installed state, the deformable sealing elements are arranged on and project from a radially inwardly pointing surface of each annular limb so as to extend over a circumference of the annular limb, as recited in claim 13. Furthermore, the sealing member in MEDYNSKI, like that of DE '738, applies an essentially axial force to axial annular surfaces of the beads 19 of the tire whereas the grooves 8 of member 5 in GB '784 apply an essentially radially inwardly directed force to an essentially circumferential outer surface (albeit tapered) above the bead 3.

For the foregoing reasons and because each of these documents fails to disclose the above-noted features of the instant invention, Applicant submits that no proper combination of these documents disclose or suggests each and every recited feature of claim 13. Accordingly, Applicant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of unpatenability under 35 U.S.C. § 103(a) and that the instant rejection is improper.

Finally, Applicant submits that dependent claim 20 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection and further requests that the above noted claims be indicated as allowable.

***New Claims are also Allowable***

Applicant submits that the new claims 38-40 are allowable over the applied art of record. Specifically, claims 38-40 depend from claims 13 and 30 which are believed to be allowable over the art of record. Accordingly, Applicant respectfully requests consideration of these claims and further

request that the above-noted claims be indicated as being allowable.

*Application is Allowable*

Thus, Applicant respectfully submits that each and every pending claim of the present invention meets the requirements for patentability under 35 U.S.C. §§ 112, 102 and 103, and respectfully request the Examiner to indicate allowance of each and every pending claim of the present invention.

*Authorization to Charge Deposit Account*

The Commissioner is authorized to charge to Deposit Account No. 19-0089 any necessary fees, including any extensions of time fees required to place the application in condition for allowance by Examiner's Amendment, in order to maintain pendency of this application.

**CONCLUSION**

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious the Applicant's invention, as recited in each of the pending claims. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

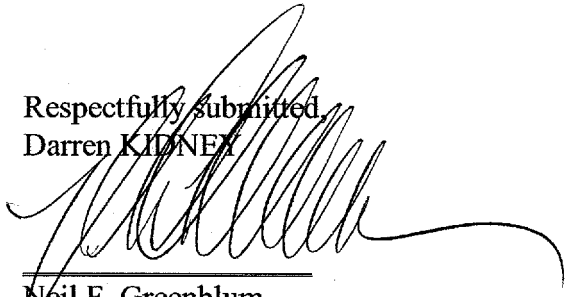
Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.



Should there be any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

February 23, 2011  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191

Respectfully submitted,  
Darren KIDNEY



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Neil F. Greenblum  
Reg. No. 28,394

**Robert W. Mueller**  
**Reg. No. 35,043**